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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/980,729	03/28/2002	Preeti Lal	PF-0687 USN	8120
22428	7590	07/22/2004	EXAMINER	
FOLEY AND LARDNER SUITE 500 3000 K STREET NW WASHINGTON, DC 20007			RAO, MANJUNATH N	
			ART UNIT	PAPER NUMBER
			1652	

DATE MAILED: 07/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/980,729

Applicant(s)

LAL ET AL.

Examiner

Manjunath N. Rao, Ph.D.

Art Unit

1652

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 30 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-6,8-10,12,15,20 and 23-29 is/are pending in the application.
- 4a) Of the above claim(s) 9,12,27 and 28 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-6,8,10,15,20,23-26 and 29 is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

Claims 1-6, 8-10, 12, 15, 20, 23-29 are currently pending and are present for examination. Claims 1-6, 8, 10, 15 after rejoinder with claims 20, 23-24, 25-26, 29 are now under consideration. Claims 9, 12, 27-28 remain withdrawn from consideration as being drawn to non-elected invention.

Applicants' amendments and arguments filed on 4-30-04, have been fully considered and are deemed to be persuasive to overcome the rejections previously applied. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. Specifically, Examiner respectfully disagrees with all of applicant's exhaustive and sometimes misplaced arguments. Without acquiescing to applicant's arguments, and based solely on claim amendments, Examiner has withdrawn the previously held rejections under 35 U.S.C. 112, 1<sup>st</sup> (enablement and written description) and 2<sup>nd</sup> paragraphs, as well as rejections under 35 U.S.C. 102(b) and (e) statutes.

***Rejoinder of restricted inventions***

Claims 1-6, 8, 10, 15 are directed to an allowable product. Pursuant to the procedures set forth in the Official Gazette notice dated March 26, 1996 (1184 O.G. 86), claims 20, 23-24, 25-26, 29, directed to the process of making or using the patentable product, previously withdrawn from consideration as a result of a restriction requirement, are now subject to being rejoined. Process claims 20, 23-24, 25-26, 29 hereby rejoined and fully examined for patentability under 37 CFR 1.104. Claims 9, 12, 27-28, not directed to the process of making or using the patentable product, will not be rejoined. Claim 9 is directed to an antibody which is structurally and

Art Unit: 1652

functionally different from the allowed polynucleotide and the polypeptide and claims 12, 27-28 are directed to methods of use of polynucleitdes that do not fall under scope of the allowed product polynucleotide, SEQ ID NO:10. Examiner would like to point out here that claims 12, 27-28 are directed to the use of "polynucleotides comprising fragments of SEQ ID NO:10" which do not fall within the scope of SEQ ID NO:10. Any previous inadvertent indication that claim 12 was examined is deeply regretted.

### ***Information Disclosure Statement***

The listing of references in the specification ( for example in Table 5) is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

### ***Conclusion***

Claims 1-6, 8, 10, 15, 20, 23-24, 25-26, 29 are allowable. However, until the cancellation of the non-elected claims, a notice of allowance cannot be issued.

This application contains claims 9, 12, 27-28 drawn to an invention nonelected with traverse in the reply filed on 4-30-04. A complete reply to the final rejection must include cancelation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Art Unit: 1652

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Manjunath N. Rao, Ph.D. whose telephone number is 703-306-5681. The examiner can normally be reached on 7.30 a.m. to 4.00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapura Achutamurthy can be reached on 703-308-3804. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-4242 for After Final communications.

Art Unit: 1652

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-0196.

A handwritten signature in black ink, appearing to read 'Manjunath N. Rao', with a stylized flourish at the end.

Manjunath N. Rao  
July 12, 2004